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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,542	02/10/2000	Bruce L Davis	60109	5321

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DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 250
TUALATIN, OR 97062

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,542

Applicant(s)

DAVIS ET AL.

Examiner

Mark Fadok

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

The examiner is in receipt of applicant's response to Office Action mailed 9/23/2003, which was received in the office 12/19/2003. Acknowledgement is made that no amendments were filed; leaving claims 1-27 as pending in this application. Applicant's arguments have been carefully considered, but were found not to be persuasive; therefore, the previous rejection is restated below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie view of Official Notice and further in view of Kenny.

In regards to claim 1, Scroggie teaches a method comprising: presenting a collection of retail items, each having an indicia associated therewith, in a bricks and mortar store offering items for sale; sensing the indicia associated with selected ones of said items (FIG 13, Item 312); compiling a list identifying the items whose indicia were sensed (FIG 14, block 406 maintains a database of customer purchase histories, and col 12, lines 1-67); storing said list in a data structure associated with a user (col 12,

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lines 8-42); and later recalling said list (col 12, lines 24-42); using said recalled list to present a customized selection of items in an on-line shopping environment. Scroggie teaches that while on-line, accessing the customers purchasing history, then selecting one or more purchasing incentives based on some aspect of the customer's prior shopping history (FIG 14, col 12, lines 7-67 and col 13, lines 1-46), and the emerging technology of online shopping (col 1, lines 26-35), but does not specifically mention that the scan data is presented to the user in a shopping environment. It is old and well known in the art that profile/preference data stored in databases and available on-line can be readily accessed and used in online shopping environments. It would be obvious to a person of ordinary skill in the art to include in Scroggie presenting scanned data to a shopper in an online shopping environment, because users shopping on-line could also benefit from the targeted incentives and the additional data would increase the effectiveness of the Scroggie. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the scanned data in a preference/profile database on-line, since it has been held that rearranging parts of an invention (where the database information is presented) involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Moreover, Scroggie teaches a customized selection of items, but does not specifically mention identifying a subset of items from a customized selection of items. Kenny teaches selecting reorder items from a list (FIG 10A). It would be obvious to a person of ordinary skill in the art to include in Scroggie the selection of items from a customized list as taught by Kenny, because the user may not want to order all the

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products or items displayed and might only want a selected group, and the inclusion of the teachings of Kenny would allow this selection process to occur.

In regards to claim 7, Scroggie teaches that while on-line, accessing the customers purchasing history, then selecting one or more purchasing incentives based on some aspect of the customer's prior shopping history (FIG 14, col 12, lines 7-67 and col 13, lines 1-46), and the emerging technology of online shopping (col 1, lines 26-35), but does not specifically mention that information gathered during online shopping is presented to a user in connection with a brick and mortar shopping environment. It is old and well known in the art that collected profile/preference data stored in databases and available on-line can be readily accessed and presented in any number of environments including a brick and mortar shopping environment. It would be obvious to a person of ordinary skill in the art to include in Scroggie the recalling of said logged database records in a brick and mortar store from preference data collected from an online shopping environment, because users in brick and mortar stores could also benefit from the targeted incentives and the addition of this data would increase the usefulness of the teachings of Scroggie. Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include information from an online shopping experience in a preference/profile database then later use it in a brick and mortar shopping environment, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70;

Claims 3-9 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenny (6,381,583) and further in view of Official Notice.

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In regards to claim 3, Kenny discloses recalling a list of products associated with the user (col 1, lines 49-57); presenting products from said list to the user for selection (col 1, lines 47-52); receiving user selections of products to be purchased (col 1, lines 46-48); receiving an indication that the user is finished selecting products (FIG 10A); Kenny teaches identifying a user, but does not specifically mention that a login identifier is used to identify the user. It is old and well known in the art that computer users who are shopping or purchasing products online are identified at some time, perhaps during login. It would be obvious to a person of ordinary skill in the art to include in Kenny a user login identifier, because this information would be needed to associate the user with previous purchase history stored in a database (col 1, lines 40-56).

Kenny also teaches additional lists can be automatically available at the beginning of the interactive virtual shopping session, including pre-prepared lists of items routinely purchased, items purchased in the past, and items due for reorder based on prior purchase history (col 4, lines 23-28), but does not specifically mention querying the user regarding the possible purchase of an item not selected by the user but on said recalled list, before completing the online shopping session. The Examiner notes that comparing lists and deriving a resultant differential is old and well known in the art and could have been used in Kenny if so desired. Also, in regards to the timing of the query (when the query is done), it would have been obvious to one having ordinary skill in the art at the time the invention was made to make a query at the end of the shopping session, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to claim 4, Kenny discloses a computer storage medium having instructions thereon causing a computer to perform the process of claim 3 (see response to claim 3).

In regards to claim 5, Kenny teaches selecting said item in accordance with a procedure that depends, in part, on the passage of a predetermined interval of time without the user selecting said item for purchase (col 6, lines 24-37).

In regards to claim 6, Kenny teaches selecting said item only if the total price of items selected by the user meets a pre-determined criterion. Kenny teaches programming means for displaying various lists of previously ordered products (col 6, lines 4-67) with the information provided in these lists including price (col 4, lines 4-65). Since Kenny does not limit the criterion by which the list is assembled and offers the user the means to establish when a list will be provided automatically, including a list that included items priced over a certain price level, the feature is considered to be inherent in the teachings of Kenny.

In regards to claim 8, Kenny discloses in an on-line shopping method, an improvement comprising displaying a virtual shopping aisle with graphical - rather than strictly textual - representations of items for sale (abstract and **FIG 4**), wherein items of potential interest to a shopper are presented more prominently than other items (**FIG 7, Special Today**).

In regards to claim 12, Kenny teaches in which the item not selected by the user, but on said recall list associated with the user, is a dessert or cookie item. Kenny does not limit the type of product that is presented on its list, therefore, the items that were

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not selected from a list presented to the user could include any number of products including deserts or cookies.

In regards to claim 13, Kenny teaches in which the item is the subject of said query only if said the user has not purchased item for a predetermined period (col 9, lines 14-33).

In regards to claim 14, Kenny teaches in which the item is the subject of said query only if the user has demonstrated a prior purchasing habit related to said item, and the omission of said item is not in accordance with said demonstrated habit (col 1, lines 25-30).

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie, and further in view of Jelen et al (6,129,276).

In regards to claim 10, Scoggie teaches sensing said selected items along aisles at which said items are displayed, away from a checkout stand. Scroggie teaches sensing selected items, but does not specifically teach sensing selected items along aisles at which said items are displayed. Jelen teaches a portable barcode reader system that can be transported to the aisles where products can be scanned (abstract, FIGs 1 and 2). It would be obvious to a person of ordinary skill in the art to include in Scoggie the portable barcode scanner and display system that is taught by Jelen, because the incentives that are offered by Scoggie could be provided at an earlier time, when a product is selected and could influence the product selection decision before the

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items are brought to the counter for check out where it is unlikely that a change in buying behavior would occur.

In regards to claim 11, Scroggie teaches sensing an RFID identifier (Jelen col 10, lines 3-6).

Claims 9,15,16,19,20,21,23,24,25 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Kenny (6,381,583) and in view of Official Notice and further in view of Scottyscan.

In regards to claim 9, Kenny teaches identifying items of potential interest by reference to the shopper's prior activity in a brick and mortar store (**FIG 7, Reorder Item**).

Claims 9,15-27, Scroogie and Kenny teach identifying items of potential interest and the presentation of a customized list (see response to claims 1 and 9), but do not specifically mention where the information contained in the database was obtained. Scottyscan teaches a hand held scanner that can input information from products in any location including various vendor locations, home pantries or even catalogs for use in creation a personalized list of products in a database. It would be obvious to a person of ordinary skill in the art to include in Scroggie and Kenny the input means as taught by Scottyscan because this method is easier and faster than scrolling through lists of products to select desired items.

Response to Arguments

Applicant's arguments filed 12/19/2003 have been fully considered but they are not persuasive.

In regards to applicant's request for references to support the examiner's use of official notice, a "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicant's arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicant's arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument concerning claim 12, that Kenny does not teach a cookie or dessert and that a genus is not sufficient to render obvious a species. The examiner maintains the current rejection and further states that the list would be considered the genus and the items upon the list the species, therefore understanding the opportunity for an infinite number of products in a store being placed on this list, the examiner has concluded that all items that could be present on a list are included as the species to the generic list. Furthermore, the examiner does not understand the applicant's apparent differentiation between a dessert and a cookie, considering that one of ordinary skill in the art might consider a cookie (species) within the definition of a dessert item (genus), an example being a fortune cookie presented at the end of a Chinese meal as a dessert. Webster's dictionary defines dessert as a sweet course or dish served at the end of a meal. Considering this definition the examiner also points the applicant's attention to FIG 6, which has presented several sweet items such as hot cocoa and granola.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-**

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4252. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

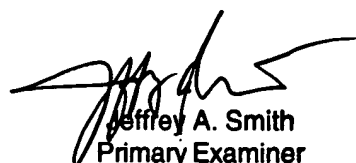
or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Mark Fadok
Patent Examiner



Jeffrey A. Smith
Primary Examiner